



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,233	11/13/2003	Robert S. Bierwith	011674-001211US	9677

20350 7590 01/14/2005

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

BATSON, VICTOR D

ART UNIT	PAPER NUMBER
----------	--------------

3671

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/713,233	Applicant(s) BIERWITH, ROBERT S.	
	Examiner Victor Batson	Art Unit 3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-14 and 30 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10 and 29 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3671

Election/Restrictions

Applicant's election without traverse of claims 1-14,29,30 in the reply filed on 11/22/04 is acknowledged.

Claim Objections

Claims 11-14,30 are objected to because of the following informalities: In claim 11 line 4, it appears that "the" should be inserted before "front". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,3,7,8,29 are rejected under 35 U.S.C. 102(b) as being anticipated by Klett et al. (3,864,853).

Klett et al. discloses a lip having an upper surface, a lower surface, a front portion, a rear portion, a plurality of holes disposed between the front portion and the rear portion and extending from the upper surface to the lower surface, and a plurality of support members 16, and a plurality of tooth assemblies 11. Given the structure of Klett et al., the claimed method steps would inherently be performed when the implement is assembled. Concerning the limitation of lip shrouds, every other tooth 11 is considered a lip shroud.

Art Unit: 3671

Claims 1,2,3,5,7,29 are rejected under 35 U.S.C. 102(b) as being anticipated by Bierwith (5,526,592).

Bierwith discloses a lip assembly including a lip, a plurality of support members 50, and a plurality of tooth assemblies including adapter shrouds and lip shrouds 24. Given the structure of Bierwith, the claimed method steps would inherently be performed when the implement is assembled.

Claims 1,2,7,29 are rejected under 35 U.S.C. 102(b) as being anticipated by Cornelius (5,852,888).

Cornelius discloses a lip assembly including a lip 12 & 14, a plurality of support members 18, and a plurality of tooth assemblies 16. Given the structure of Cornelius, the claimed method steps would inherently be performed when the implement is assembled. Concerning the limitation of lip shrouds, every other tooth is considered a lip shroud since they inherently help to protect the lip.

Claims 1,9,10,29 are rejected under 35 U.S.C. 102(b) as being anticipated by Bierwith (4,413,432).

Bierwith discloses a lip assembly including a lip, a plurality of support members (unnumbered, but shown in figure 3 between projections 13), and a plurality of tooth assemblies 20. Given the structure of Cornelius, the claimed method steps would inherently be performed when the implement is assembled. Concerning the limitation of lip shrouds, every other tooth is considered a lip shroud since they inherently help to

Art Unit: 3671

protect the lip. Additionally, figure 3 shows the use of block elements (not numbered but located behind receptacle 17).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klett et al. (3,864,853).

Klett et al., discloses a lip assembly as described previously, but lacks specifying that the lip is comprised of steel.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to make the lip from steel since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 5,6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornelius (5,852,888) in view of Bierwith (5,526,592).

Cornelius discloses a lip assembly as described previously, but lacks using an adaptor shroud.

Art Unit: 3671

Bierwith teaches that it is known in the art to use an adaptor shroud with a tooth assembly for an excavator. The use of a shroud adds protection from damage and wear experienced during excavation.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the device of Cornelius, by using an adaptor shroud as taught by Bierwith, to provide added protection from damage and wear during excavation.

Concerning claim 6, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to make the lip from steel since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Allowable Subject Matter

Claims 11-14,30 are allowed.

Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Batson whose telephone number is (703) 305-6356. The examiner can normally be reached on Monday through Friday (except Wednesday).

Art Unit: 3671

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on (703) 308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 11, 2005



Victor Batson
Primary Examiner
Art Unit 3671